

Claim Rejections Under 35 U.S.C. § 103

Claims 6-9 and 11-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,146,487 (“Bergsman”) in view of U.S. Patent No. 6,483,899 (“Agraharam”) and U.S. Patent No. 6,956,831 (“Mahr”). This rejection is respectfully traversed.

Each of the independent claims 6, 7, 9, 12, 13, and 15 includes the feature that a “plurality of available pre-prepared messages are pre-programmed by a called party.” In the Office Action, the Examiner acknowledged that Bergsman and Agraharam in combination fail to disclose this feature. The Examiner alleges that Mahr teaches this feature at column 7, lines 28-45. The Applicant respectfully disagrees for the following reasons.

The portion of Mahr cited by the Examiner describes the manner in which a “subscriber” can create and store a wireless initiated message (“WIM”). After defining the WIM messages, the subscriber can begin using them (col. 7, line 60). Each of the embodiments disclosed by Mahr includes the subscriber sending a WIM message to an intended recipient (*i.e.* the called party). In Mahr, the subscriber is the *calling* party. Thus, Mahr discloses a system in which a plurality of pre-defined messages are created by a *calling* party, not the *called* party as recited in each of the independent claims 6, 7, 9, 12, 13, and 15. Accordingly, the combination of Bergsman, Agraharam, and Mahr fails to show or suggest each of the features recited in claims 6, 7, 9, 12, 13, and 15.

In addition, assuming *arguendo* that each of the recited features of claims 6, 7, 9, 12, 13, and 15 were provided by the combination of Bergsman, Agraharam, and Mahr, Applicant respectfully submits that a valid motivation to combine Bergsman, Agraharam, and Mahr has not been established by the Examiner. The Examiner asserts without any underlying reasoning that

it would have been obvious to combine the references. However, the Examiner has not identified *objective evidence* of any motivation or suggestion in either Bergsman, Agrapharam, or Mahr to modify Bergsman's audio text message system with Agrapharam's voice messaging system and Mahr's wireless initiated messaging system so that a text message includes both a pre-prepared message and a converted text message portion that is converted from a voice message, in which the pre-prepared message is selected from a plurality of available pre-prepared messages that are pre-programmed by a called party.¹ Bergsman merely pertains to personalizing phone delivered messages for sending to a recipient on a later date (col. 4, ll. 52-64). Bergsman uses the phone keypad and voice recording from the caller to personalize the pre-determined messages (col. 1, ll. 35-57). Likewise, Agrapharam merely pertains to a text message that is converted from a voice message, but does not discuss modifying the text message to include a pre-prepared message. Mahr, which merely discloses a system for initiating wireless messaging, does not provide that which Bergsman and Agrapharam lack with respect to claims 6, 7, 9, 12, 13, and 15.

¹ The USPTO is held to a *rigorous* standard when trying to show that an invention would have been obvious in view of the combination of two or more references. *See, In re Sang Su Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), *citing, e.g., In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”). In *Lee*, the Federal Circuit further emphasized that the “need for specificity pervades this authority.” (*Lee* at 1433 (*citing In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”))). The factual inquiry into whether to combine references “must be based on objective evidence of record.” *Lee* at 1433.

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/843,771

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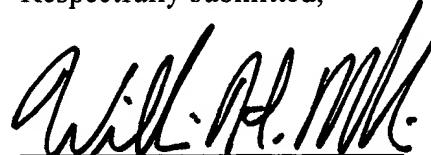
In view of the above, Bergsman, Agraaharam, and Mahr, whether considered separately or in combination, fail to show or suggest the present invention as recited in independent claims 6, 7, 9, 12, 13, and 15. Thus, independent claims 6, 7, 9, 12, 13, and 15 are patentable over Bergsman, Agraaharam, and Mahr. Dependent claims are allowable for at least the same reasons. Accordingly, removal of this rejection is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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